UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/998,111
Filing Date: November 30, 2001
Appellant(s): HUBBARD ET AL.

Hunter E. Webb
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/24/2006 appealing from the Office action mailed 8/23/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,848,396   Gerace   12-1998

| 6,078,916 | Culliss | 6-2000 |
| 6,342,907 | Petty | 1-2002 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 11-21, 23-33, 35-47, 49-55 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Gerace (5,848,396) in view of Culliss (6,078,916).

Claim 1, 13, 25, 39: Gerace discloses a system, method, medium, software product for

presenting marketing content on a web page, the system comprising:

(a)   a marketing page element, said marketing page element providing storage for data items

(Fig. 2; Fig. 3a);

(b)   a web page connected to said marketing page element for presenting said data items (Fig.

2; Fig. 3a); and

(c)   a marketing content selection system connected to said marketing page element, wherein

said marketing content selection system is adapted to select said data items to be stored in said

marketing page element (Fig. 2; Fig. 3a; col 5, lines 54-63; col 7, lines 24-37; col 5, lines 40-53;

Fig. 4a; col 4, lines 23-29; col 16, lines 41-47; col 17, lines 1-5; col 4, lines 39-45; col 16, lines

55-67).

Additionally, Gerace discloses a marketing page element placed on the web page and that

these components are for placing on a web page (col 1, lines 30-45; col 1, lines 60-65; col 6,

lines 45-52; col 17, lines 60-67; col 20, lines 10-20; col 16, lines 36-55; col 14, lines 25-35; col

2, lines 24-30; col 4, lines 25-30;).

Gerace discloses design of a webpage and marketing strategy for determining marketing

content (col 5, lines 19-24; col 20, lines 10-20; col 12, lines 21-56; col 18, lines 10-26).

Gerace discloses taking the information currently displayed on the web page into account

(col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5).

Gerace does not explicitly disclose that a marketing element can be placed anywhere on

the webpage.

However, Gerace discloses advertisements placed in a variety of locations including top,

bottom, sides, beginning and end as disclosed above and in the Applicant's Amendment dated

2/22/05 on page 19.

Also, Gerace discloses that advertisements can be a form of agate information:

"(18) In accordance with another aspect of the present invention, there are

Agate Objects for providing the agate information and a Sponsor Object. In a preferred

embodiment, the agate information includes stock information, advertisements, sports statistics,

weather reports and the like. With regard to stock information, an Agate Object routine

receives stock data on line, parses the data and makes a value-added calculation. As a result,

the stock information is made searchable by variables such as price-earnings ratio, and

the like" (col 2, line 60-col 3, line 5).

Therefore, the functionality in Gerace concerning agata data can also apply to advertising

data.

Also, Gerace discloses that agate information can be placed anywhere on the web page:

"(19) Display preferences include orientation, color scheme, screen quadrant/location and

the like, indicated with respect to the category of information (col 6, lines 30-35);

(48) Also, categories that a user selects to view further which are not on his Home Page are added with three options: customize, remove from first page, or move to a user-specified xyz position" (col 11, lines 50-56).

Therefore, it would be obvious to Gerace that a marketing page element can be placed anywhere on the webpage.

As a further example of this, Culliss discloses that a marketing page element can be placed anywhere on the webpage:

"(69) In this manner, the purchase of an advertising banner, positioned anywhere on a web site or search page, will allow users to. . . and/or categories for the matched article which is associated (in any possible way) with the advertising banner" (col 17, line 65-col 18, line 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gerace's advertisements can be placed anywhere on the webpage. One would have been motivated to do this in order to provide further flexibility in the placement of the advertisement in a place of interest to the user.

Also, Gerace's that advertisements can be for a marketed item:

"(15)   In accordance with another aspect of the present invention, there is a module (e.g., advertisement module) that records history of users viewing the advertisements. For each advertisement, the module records (i) number of times viewed by a user; (ii) number of times selected for further information by a user, and/or (iii) number of purchases initiated from display of the advertisement to a user" (col 2, lines 35-42).

An advertisement that results in a purchase is equivalent to presenting data items related to to a marketed item such as a product or coupon.

Gerace discloses utilizing a marketing strategy for selecting the marketed item that is
displayed on a web page:

"(82) Based on these recorded details, program 31 constantly and automatically tailors
screen views (content and presentation) and advertisement selection (subject matter and
presentation) for the user (col 17, lines 4-10);

(14)   The tracking and profiling member also records demographics of each
user. As a result, the data assembly is able to transmit advertisements for display to users based
on psychographic and demographic profiles of the user to provide targeted marketing (col 2,
lines 30-35);   ·

(90) For example, a report comprises several defined elements, including overall success
of the advertisement, breakdown by requested demographic elements, comparison of target
market with control group, number of click through requested versus number achieved to date,
as well as the time remaining in an advertisement. Finally, program 31 completes a regression
analysis using data stored in Ad Package Objects 33b and User Objects 37, and suggests other
demographic groups which a sponsor might want to consider for a subsequent ad (col 18, line
64-col 19, line 6);

(97)   In order to achieve rapid and direct benefits from the detailed reporting of program
31, program 31 allows the sponsor to enter new advertising contracts on line. If a sponsor
recognizes that, for example, 25-35 year-old women tend to purchase frequently and respond to
their still, forest green colored advertisements most often, program 31 allows sponsors to place
that type of ad in front of the subject target market segment during a reporting cycle. Thus,

program 31 enables updating of the Sponsor and Ad Objects 33 during a reporting cycle to

accommodate the foregoing (col 20, lines 9-19);

[Claim] 6. Apparatus as claimed in claim 5 wherein the tracking and profiling member

further provides demographic information about a user; and for each advertisement, the data

assembly transmits the advertisement for display with agate information to users having a

psychographic profile and a demographic profile substantially matching the target profile of the

advertisement to provide targeted marketing (col 35, lines 14-20);

(98) With respect to reporting, if the reports of program 31 show that customers respond

to still advertisements more often than moving ones, bright colors more often than darker ones,

graphics rather than text, large text rather than small, detailed text or square advertisements

rather than bar style ones, such is relayed to the sponsors/advertisers (col 20, lines 10-25).

(55) Briefly, an Overview Report provides a review by ad package. The number

of hits and number of click throughs purchased and achieved are indicated among

the cost of the package and date specified by the ad package" (col 12, lines 62-69).

Hence, Gerace discloses that advertisements can be displayed to users, that

advertisements can be utilized to incite purchases from users. Gerace further discloses that

certain advertisements can be targeted to certain markets or groups of users and that certain

advertisements can be displayed to users in certain ways in order to illicit more favorable

responses, such as purchases, from a user. Therefore, Gerace discloses utilizing a marketing

strategy for selecting the marketed item that is displayed on a web page.

Claim 2, 14, 26, 40: Gerace and Culliss disclose the system, method, medium, software

product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and

Gerace further discloses that said marketing page element comprises a plurality of marketing

page element items, and wherein at least one data item stored in said marketing page element is

connected to one of said plurality of marketing page element items (Fig. 4a; col 4, lines 23-29;

col 16, lines 41-47; col 17, lines 1-5; col 16, lines 24-29).

Claim 3, 15, 27, 41: Gerace and Culliss disclose the system, method, medium, software

product for presenting marketing content on a web page as claimed in claim 2, 14, 26, 40, and

Gerace further discloses that said web page comprises a plurality of web page elements, wherein

each of said web page elements is connected to a marketing page element item of said plurality

of marketing page element items, and wherein each of said web page elements is used to present

a data item connected to said marketing page element item (Fig. 3a; col 5, lines 54-63; col 7,

lines 24-37).

Claim 4, 16, 28, 42: Gerace and Culliss disclose the system, method, medium, software

product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and

Gerace further discloses that said marketing content selection system is adapted to determine

data items for storage in said marketing page element in accordance with a marketing strategy

(col 12, lines 21-42; col 13, lines 10-20).

Additionally, Gerace discloses utilizing if-then logic related to a marketing strategy:

"(97) If a sponsor recognizes that, for example, 25-35 year-old women tend to purchase

frequently and respond to their still, forest green colored advertisements most often, program 31

allows sponsors to place that type of ad in front of the subject target market segment during a

reporting cycle. Thus, program 31 enables updating of the Sponsor and Ad Objects 33

during a reporting cycle to accommodate the foregoing.

(98)   With respect to reporting, if the reports of program 31 show that customers respond

to still advertisements more often than moving ones, bright colors more often than darker ones,

graphics rather than text, large text rather than small, detailed text or square advertisements

rather than bar style ones, such is relayed to the sponsors/advertisers" (col 20, lines 10-25).

Also, note that the targeted marketing features, including targeting both advertising

content and advertising format to certain target user(s), disclosed in the rejection of the

independent claim above and in the immediate citations above constitute utilizing a marketing

strategy and a business rule. For example, the business rule would be something like if a target

age group can be identified that responds to certain advertisements more favorably, then market

that age group with that type of advertisement.

Claim 5, 17, 29, 43: Gerace and Culliss disclose the system, method, medium, software

product for presenting marketing content on a web page as claimed in claim 4, 16, 28, 42, and

Gerace further discloses that the marketing content selection system determines data items to be

stored in said marketing page element based on information available to said marketing content

selection system pertaining to the person viewing the web page (Fig. 3b; col 4, lines 20-35).

Additionally, Gerace further discloses taking the information currently displayed on the

web page into account (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5).

Gerace further discloses determining marketing content based on a combination of

information displayed on the webpage and information available pertaining to the person

viewing the web page (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5; col

2, lines 30-35).

Claim 6, 18, 30, 44: Gerace and Culliss disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and Gerace further discloses a marketing content retrieval system connected to said marketing page element, said marketing content retrieval system adapted to provide said data items to said marketing page element for storage in said marketing page element (Fig. 2; Fig. 3a; col 5, lines 54-63; col 7, lines 24-37).

Claim 7, 19, 31, 45: Gerace and Culliss disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 6, 18, 30, 44, and Gerace further discloses that the marketing content retrieval system comprises a first source of data items, wherein data items are retrieved from said first source of data items for subsequent storage in said marketing page element, said first source of data items comprising at least one of the following: a database, a data stream, a storage device, a memory device (Fig. 2; Fig. 3a; col 3, lines 54-62; col 3, lines 39-42).

Claim 8, 20, 32, 46: Gerace and Culliss disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 7, 19, 31, 45, and Gerace further discloses that each data item in said first source of data items comprises one of the following: text, an image, an audio file, a video file, a movie, a document, a hyperlink, an animation, an object capable of accepting input, an object capable of presenting output (col 1, lines 31-44).

Claim 9, 21, 33, 47: Gerace and Culliss disclose the system, method, medium, software product for presenting marketing content on a web page as claimed in claim 8, 20, 32, 46, and Gerace further discloses that the marketing content retrieval system is further adapted to provide

at least one data item to said marketing page element from a pre-determined second source of

data items in the event that at least one data item to be stored in said marketing page element as

determined by the marketing content selection system cannot be retrieved from the first source of

data items (col 16, lines 55-67;).

Claim 11, 23, 35, 49: Gerace and Culliss disclose the system, method, medium, software

product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39, and

Gerace further discloses that the marketing content selection system comprises at least one of the

following components: a rules processing engine, a table, a collaborative filtering engine, a

selection program (col 16, lines 37-48; col 3, lines 56-61).

Claim 12, 24, 36, 50: Gerace and Culliss disclose the system, method, medium, software

product for presenting marketing content on a web page as claimed in claim 3, 15, 27, 41.

Gerace further discloses at least one of the following:

(i)   a first set of tools for making modifications to the manner in which the marketing content

selection system determines the data items to be stored in said marketing page element, wherein

the modifications can be effected without changing either the layout of said web page elements

on said web page or said data items (col 11, lines 24-36; col 11, lines 45-56);

(ii)   a second set of tools for making modifications to said data items, wherein the

modifications can be effected without changing either the layout of said web page elements on

said web page or the manner in which the marketing content selection system determines the

data items to be stored in said marketing page element (col 11, lines 50-55; col 20, lines 13-15;

col 6, lines 31-35); and

(iii)   a third set of tools for making modifications to the layout of said web page elements on

said web page, wherein the modifications can be effected without changing either said data items

or the manner in which the marketing content selection system determines the data items to be

stored in said marketing page element (col 6, lines 31-40; col 17, lines 1-5).

Claim 37: Gerace and Culliss disclose the above. Gerace further discloses a computer

program comprising computer program code means adapted to perform all the steps of claim 13

when said program is run on a computer (Fig. 1; col 3, lines 50-62).

Claim 38: Gerace and Culliss disclose a computer program as claimed in claim 37,

Gerace further discloses that embodied on a computer readable medium (col 3, lines 55-62).

Claim 51: Gerace and Culliss disclose a computer program product comprising: Gerace

further discloses that a computer-readable signal-bearing medium (col 16, lines 55-60; col 36,

lines 49-58; col 3, lines 45-62); means in said medium for accomplishing the method of any of

claims 13 to 24.

Claim 52: Gerace and Culliss disclose the product of claim 51, Gerace further discloses

that said medium is a recordable data storage medium (col 3, lines 55-62).

Claim 53: Gerace and Culliss disclose the product of claim 51.

Gerace does not explicitly disclose that said medium is a modulated carrier signal.

However, Gerace discloses the utilization of networks, the Internet, transmissions,

satellite, radio, and FM radio (col 16, lines 55-60; col 36, lines 49-58; col 3, lines 45-62) and the

display of information along with radio or television transmissions (col 36, lines 49-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Gerace's utilization of satellite and radio to Gerace's utilization of

networks. One would have been motivated to do this in order to provide the flexibility of a

wireless manner of data transmission.

Claim 54: Gerace and Culliss disclose the product of claim 53, Gerace further discloses

that said signal is a transmission over a network (Fig. 1; col 3, lines 50-54).

Claim 55: Gerace and Culliss disclose the product of claim 54, Gerace further discloses

that said network is the Internet (Fig. 1; col 3, lines 50-54).

Claims 10, 22, 34, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gerace (5,848,396) in view of Culliss (6,078,916) and in further view of Petty (6,342,907).

Claim 10, 22, 34, 48: Gerace and Culliss disclose the system, method, medium, software

product for presenting marketing content on a web page as claimed in claim 1, 13, 25, 39.

Gerace further discloses the utilization of Java and other formats (col 13, lines 51-55) and

the utilization of web pages and servers (col 3, lines 54-58; col 1, lines 29-45).

Gerace does not explicitly disclose the utilization of Data Bean or a Java Server Page.

However, Petty implies the utilization of Java Server Pages and discloses the utilization

of Data Bean (col 5, lines 20-25; col 9, line 65-col 10, line 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Java Server Pages and Petty's Data Beans to Gerace's utilization

of Java, servers, the Internet, and webpages. One would have been motivated to do this in order

to provide greater architecture flexibility and platform independence.

(10) Response to Argument

Examiner notes that in the Response to Arguments below that the simpler issues are addressed first and the more complicated issues later in this section.

On page 9 of the Appellant's Appeal Brief dated 3/24/2006, Appellant states that Gerace does not disclose 'a marketed item. . .a product or a coupon. . .marketing content'.

However, Gerace's advertisements are for a marketed item:

"(15)   In accordance with another aspect of the present invention, there is a module (e.g., advertisement module) that records history of users viewing the advertisements. For each advertisement, the module records (i) number of times viewed by a user; (ii) number of times selected for further information by a user, and/or (iii) <u>number of purchases initiated from display of the advertisement to a user</u>" (col 2, lines 35-42);

<u>Also the Sponsor and User Objects track how many times each piece of advertisement information is shown to, is selected by and/or spawns a purchase by users</u> (col 3, lines 10-15);

(33)   Referring back to the Home Page 43 of FIG. 4a, also included is a Travel Category. Data/information displayed in that category include travel and other ticket <u>purchases</u> of a user within an approaching date and <u>specials advertised in areas of interest to the user</u> (col 9, lines 7-13);

<u>discount fares to cities the user has examined</u>" (col 32, lines 13-15).

An advertisement that results in a purchase or advertised specials or offering discount

products/services as disclosed above are equivalent to presenting data items related to a

marketed item such as a product or coupon.

On page 9, Appellant states that Gerace does not disclose a "marketing strategy...

specified by a business rule in an if-then (action) format".

However, Gerace further discloses that said marketing content selection system is

adapted to determine data items for storage in said marketing page element in accordance with a

marketing strategy (col 12, lines 21-42; col 13, lines 10-20).

Additionally, Gerace discloses utilizing if-then logic related to a marketing strategy:

"(97) If a sponsor recognizes that, for example, 25-35 year-old women tend to purchase

frequently and respond to their still, forest green colored advertisements most often, program 31

allows sponsors to place that type of ad in front of the subject target market segment during a

reporting cycle. Thus, program 31 enables updating of the Sponsor and Ad Objects 33

during a reporting cycle to accommodate the foregoing.

(98)   With respect to reporting, if the reports of program 31 show that customers respond

to still advertisements more often than moving ones, bright colors more often than darker ones,

graphics rather than text, large text rather than small, detailed text or square advertisements

rather than bar style ones, such is relayed to the sponsors/advertisers" (col 20, lines 10-25).

Also, note that the targeted marketing features, including targeting both advertising

content and advertising format to certain target user(s), disclosed in the rejection of the

independent claim above and in the immediate citations above constitute utilizing a marketing

strategy and a business rule. For example, the business rule would be something like if a target

age group can be identified that responds to certain advertisements more favorably, then market

that age group with that type of advertisement.

The preceding was based on the Rejection above.

Also, the following is in regards to the combination of the prior art rendering obvious a

marketing strategy.

Please note that Applicant's addition of features concerning a marketing strategy in the

independent claims has been minimally defined. Hence, what constitutes a marketing strategy or

how a marketing strategy can be utilized is open to a broad interpretation.

Gerace discloses utilizing a marketing strategy for selecting the marketed item that is

displayed on a web page:

"(82) Based on these recorded details, program 31 constantly and automatically tailors

screen views (content and presentation) and advertisement selection (subject matter and

presentation) for the user (col 17, lines 4-10);

(14)   The tracking and profiling member also records demographics of each

user. As a result, the data assembly is able to transmit advertisements for display to users based

on psychographic and demographic profiles of the user to provide targeted marketing (col 2,

lines 30-35);

(90) For example, a report comprises several defined elements, including overall success

of the advertisement, breakdown by requested demographic elements, comparison of target

market with control group, number of click through requested versus number achieved to date,

as well as the time remaining in an advertisement. Finally, program 31 completes a regression

analysis using data stored in Ad Package Objects 33b and User Objects 37, and suggests other

demographic groups which a sponsor might want to consider for a subsequent ad (col 18, line

64-col 19, line 6);

(97) In order to achieve rapid and direct benefits from the detailed reporting of program

31, program 31 allows the sponsor to enter new advertising contracts on line. If a sponsor

recognizes that, for example, 25-35 year-old women tend to purchase frequently and respond to

their still, forest green colored advertisements most often, program 31 allows sponsors to place

that type of ad in front of the subject target market segment during a reporting cycle. Thus,

program 31 enables updating of the Sponsor and Ad Objects 33 during a reporting cycle to

accommodate the foregoing (col 20, lines 9-19);

[Claim] 6. Apparatus as claimed in claim 5 wherein the tracking and profiling member

further provides demographic information about a user; and for each advertisement, the data

assembly transmits the advertisement for display with agate information to users having a

psychographic profile and a demographic profile substantially matching the target profile of the

advertisement to provide targeted marketing (col 35, lines 14-20);

(98) With respect to reporting, if the reports of program 31 show that customers respond

to still advertisements more often than moving ones, bright colors more often than darker ones,

graphics rather than text, large text rather than small, detailed text or square advertisements

rather than bar style ones, such is relayed to the sponsors/advertisers (col 20, lines 10-25);

(55) Briefly, an Overview Report provides a review by ad package. The number

of hits and number of click throughs purchased and achieved are indicated among

the cost of the package and date specified by the ad package" (col 12, lines 62-69).

Gerace further discloses varying how many time or how often an advertisement is show, what types of advertising is shown to who, and to who advertising is shown in order to maximize advertising effectiveness (col 12, lines 21-56).

Hence, Gerace discloses that advertisements can be displayed to users, that advertisements can be utilized to incite purchases from users. Gerace further discloses that certain advertisements can be targeted to certain markets or groups of users and that certain advertisements can be displayed to particular user(s) in certain ways in order to illicit more favorable responses, such as purchases, from a user. Therefore, Gerace discloses utilizing a marketing strategy for selecting the marketed item that is displayed on a web page.

On page 10, Appellant states that the prior art does not disclose "a web page that is a Java Server Page. . .Data Beans".

However, Gerace further discloses the utilization of Java and other formats (col 13, lines 51-55) and the utilization of web pages and servers (col 3, lines 54-58; col 1, lines 29-45).

Gerace does not explicitly disclose the utilization of Data Bean or a Java Server Page.

However, Petty implies the utilization of Java Server Pages and discloses the utilization of Data Bean (col 5, lines 20-25; col 9, line 65-col 10, line 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Java Server Pages or other Java related features and Petty's Data Beans to Gerace's utilization of Java, servers, the Internet, and webpages. One would have been motivated to do this in order to provide greater architecture flexibility and platform independence and to take fuller advantage of the Java capabilities.

The preceding was based on the Rejection above.

Examiner notes that a 35 USC 103 rejection was made that it would have been obvious for Gerace to utilize other features of Java related to server processing since Gerace and Petty disclose utilizing various features of Java and Gerace discloses server processing functions.

On page 6 of the Appellant's Appeal Brief dated 3/24/2006, Appellant states, "The Office does not specifically indicate which feature or features in figures 2 and 3a of Gerace teach or suggest the marketing page element of the claimed invention. However, none of the elements of the figures cited by the Office includes is both placed on a web page and provides storage for data items having marketing content for a marked item for displaying on the web page. . . although the above passages of Gerace teach web pages, neither of the above passages teaches or suggests an element of the web page for storing marketing content for a marketed item for displaying on the web page."

On page 7, Appellant states, "To this extent. the above passages cited by the Office teach the storage and / or display of data which may include advertising, but does not teach or suggest that the objects into which the data is stored are elements of a web site or that the data to be displayed on a web site is stored in a element of the web site. . .However, here again Gerace never teaches or suggests that the entered data is stored in an element of the web site."

On page 8, Appellant states, "This is in sharp contrast with the cited portions of Gerace, in which the various features are not taught to be stored in a discrete element of the web page that is placed on the web page, to include data items to be displayed on the web page, or to have marketing content."

However, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is

being referred to. Also, in response to applicant's arguments against the references individually,

one cannot show nonobviousness by attacking references individually where the rejections are

based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner notes that

a 35 USC 103 rejection was made utilizing the combination of Gerace and Culliss and that it is

the combination of Gerace and Culliss that renders the features of the Applicant's claims

obvious.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims

that are being rejected with the prior art. Also, although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van

Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are

given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664

(Fed. Cir. 2000).

Examiner notes that in Appellant's Remarks dated 6/29/2005, Appellant admits on page

19 that Gerace discloses the following,

"The Office yet still further cites a passage in Gerace that teaches, in response to a

request from a user, assembling data from a pertinent agate source, formatting the data into

tables, returning it to the server, and displaying appropriate advertisements. Col. 16, lines 45-

52."

Displaying appropriate advertisements on a web page is equivalent to displaying data

items on a web page that have marketing content. Also, Examiner notes that the terms 'discrete

element' do not appear in the Applicant's independent claim 1. Also, Examiner notes that

Gerace's Fig. 2 and Fig. 3a disclose a marketing page element that is placed on the web page, the

marketing page element providing storage for data items.

Gerace's Ad Module of Fig. 2 provides storage for data items having marketing content,

wherein the data items are for displaying on the web page (Fig. 2 and below):

"(13)   With respect to the advertisement module 75, program controller 79 obtains

sponsor submitted advertisements from module 75 and generates a screen view formatted

according to user preferences as determined from the psychographic profile in the user profiling

member 73.   That is, program controller 79 enables display of advertisements customized to the

user, as to content and presentation . . .   Program controller 79 obtains the content from the

advertisement module 75. . ." (col 5, lines 15-25).

Also, in Gerace's Fig. 2 and Fig. 3a, Gerace discloses that Ads that include data items are

selected to be placed into a Page Display where the Page Display has certain areas designated for

displaying marketing content and Gerace discloses that the content (advertising and non-

advertising) can be considered as items:

"(28)   In each of the foregoing formats, the preferred embodiment includes incorporation

of ads or sponsorship indications as top and/or closing banners (col 8, lines 12-15);

(24)   Returning to FIG. 3a, the set of Page Display Objects 35a-35c defines the screen

views transmitted and displayed to end users.   A Page object 35a cross references a User

Interface Object 37c which specifies which Page Display Object 35c and which agate

information (content and presentation) is appropriate for the current user.   Page Data Objects

35b hold the agate or other data to be displayed to end users.   Included are advertisements

objects themselves) which may be integrated into the agate data.   Preferably advertisements are

positioned along the periphery (i.e., above, below, left or right) of the agate data, as defined by a

respective Page Display Object 35c. Accordingly, Page Data Objects 35b support Page Display

Objects 35c which outline the possible screen content and presentation formats in which agate

data advertisements are to be displayed (col 7, lines 23-37);

(23) Specifically, User Viewing History Object 37f records an item identification (either

agate or advertisement) and orientation of that item for each item displayed to (and hence

viewed by) the user in a session" (col 7, lines 5-10).

Also, Fig 3a. discloses that for the Page Display it is determined what placements in

terms of categories and content and advertisements need to be filled for a user, then the content

and advertising for those placements is stored in objects ('Page Data Objects hold the agate or

other data to be displayed to end users', see below) for display to the user. Hence, Gerace

discloses a marketing page element placed on the web page, providing storage for data items

having marketing content, wherein the data items are for displaying on the web page:

"(24) Returning to FIG. 3a, the set of Page Display Objects 35a-35c defines the screen

views transmitted and displayed to end users. A Page object 35a cross references a User

Interface Object 37c which specifies which Page Display Object 35c and which agate

information (content and presentation) is appropriate for the current user. Page Data Objects

35b hold the agate or other data to be displayed to end users. Included are advertisements

(objects themselves) which may be integrated into the agate data. Preferably advertisements are

positioned along the periphery (i.e., above, below, left or right) of the agate data, as defined by a

respective Page Display Object 35c. Accordingly, Page Data Objects 35b support Page Display

Objects 35c which outline the possible screen content and presentation formats in which agate

data advertisements are to be displayed" (col 7, lines 23-36).

Also, Gerace's displaying advertising content on a web page is equivalent to displaying marketing content on a web page.

Also, Gerace discloses that advertisements can be a form of agate information:

"(18) In accordance with another aspect of the present invention, there are Agate Objects for providing the agate information and a Sponsor Object. In a preferred embodiment, the <u>agate</u> information includes stock information, <u>advertisements,</u> sports statistics, weather reports and the like. With regard to stock information, an Agate Object routine receives stock data on line, parses the data and makes a value-added calculation. As a result, the stock information is made searchable by variables such as price-earnings ratio, and the like" (col 2, line 60-col 3, line 5).

Therefore, the functionality in Gerace concerning agata data can also apply to advertising data.

Hence, Gerace discloses the features of the Applicant's marketing page element as disclosed in the Applicant's claims.

Hence, the combination of Gerace and Culliss renders obvious the features of the Applicant's claims.
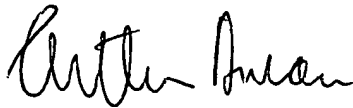

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Arthur Duran

Primary Examiner

4/26/2006

Conferees:

Eric Stamber

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